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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,962	03/26/2004	Clifton A. Alferness	11998.5USC8	7915

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Attn: Anna M. Nelson
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EXAMINER

GILBERT, SAMUEL G

ART UNIT	PAPER NUMBER
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3736

DATE MAILED: 07/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No. 10/809,962	Applicant(s) ALFERNES ET AL.	
	Examiner Samuel G. Gilbert	Art Unit 3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18, 19 and 22-33 is/are pending in the application.
- 4a) Of the above claim(s) 29-33 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18, 19, and 22-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Newly submitted claims 29-33 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the product can be used in another surgical procedure such as a hernia repair or an urinary incontinence sling procedure or outside the surgical field for a small aquarium fish net or insect net.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 29-33 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 18, 19, 22, 23, 25 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by McMurray(5,339,657).

Claims 18, 19, 22, 23 and 25 – McMurray teaches a mesh including a material forming a diamond pattern. It is the examiner's position that the diamond pattern provides a different amounts of expansion for forces applied in different directions. Any of the linear strands of the mesh material can be considered a longitudinal axis. After the longitudinal axis is selected the strands crossing the longitudinal axis would be the diagonal axis. The applicant defines jacket on page 9 lines 16-21, this definition includes a net that is long enough to pass half way around the heart to apply constraining forces at least at diametrically apposing aspects of the heart. The mesh of McMurray is at least large enough to surround a heart. The net is inherently capable of having the material oriented with respect to the heart as claimed.

McMurray teaches the use of the net in fish nets(at least some of which would be large enough to contain an adult human's heart) which would be shaped to

circumferentially surround the heart and being of a flexible material is adapted to be adjusted to the size required to perform the recited functions.

Each of the legs are formed by a plurality of fibers.

Claim 28 – the mesh of McMurray is capable of performing the recited functional language.

Claims 18, 22-24 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Shibamoto(4,196,534).

Shibamoto teaches a knit bag of a size which is adapted to be secured to the heart and adjusted(by gathering excess material and suturing it together) and thereby constrain at least a lower portion of the heart. The bag is formed with interlocking strands which exhibit different expansion in response to forces applied in different directions, column 1 lines 65-68. The bag is capable of circumferentially surrounding the heart. The label –3- at least partially coats the strands –2-.

Claim 28 – the device is capable of performing the functional language as recited.

Claims 18, 22-24, and 26-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Alferness(5,702,343)

The applied reference has a common inventor and assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e)

might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

Alferness teaches an open mesh cardiac reinforcement device. By definition, Webster's Ninth New Collegiate Dictionary, pg 744, mesh is defined as including knit structure. It is the examiner's position that an open knit would exhibit different expansion in response to forces in different direction. It is generally accepted that knit material provides different expansion in different directions.

Claims 26 and 27 – the device can include at least stainless steel to provide markers.

Claim 28 – the apparatus limits expansion, see the abstract.

Response to Arguments

Applicant's arguments filed 5/3/2005 have been fully considered but they are not persuasive. The applicant argues Sizing and Directional Compliance.

With regard to the Sizing argument, the applicant argues that the claim has been amended to recite the jacket material is dimensioned so as to be adjusted on the heart to conform to the external geometry of the heart and surrounding at least the ventricles. First, the claims do not include the limitation "surrounding at least the ventricles". Regarding the size limitations of McMurray, the applicant argues that McMurray teaches a device for large nets for fishing(fishing), cargo, sports, etc. and further argues

that changing the size would destroy the usefulness of the net as disclosed as shown by the citation of Ex parte Crigler. It is the examiners position that the fish net of McMurray can range from small nets for one gallon fish bowls to large nets for commercial fishing because no size limitations have been set forth in McMurray. Changing the size of the net will not lose the usefulness of the net as argued in Ex parte Crigler. Nets useful for a variety of purposes would be sized to surround the heart as claimed.

Regarding the Shibamoto reference the applicant argues that the bag is too large to be used around the human heart. The examiner agrees that the dimensions of the bag set forth in Shibamoto is larger than the average adult human heart. However, a bag larger than the heart may be used in that the applicant teaches that one way to size a bag is to use a bag larger than the heart and after placing the bag on the heart gathering the excess material and suturing the excess material to properly size the bag.

It is also the examiner's position that Shibamoto does not limit the size of the bag using the knit material as described. For example it is the examiner's position that a bag can be made designed to hold one onion, 4 onions, 6 onions, or twenty lbs of onions as set forth by example in Shibamoto and therefore changing the size of the bag would not lose the usefulness of the bag as argued by the applicant by citing Ex parte Crigler. It is clearly evident that a bag of appropriate size can be supplied by the teaching of Shibamoto.

Regarding the directional compliance, as set forth above, Shibamoto teaches the differential expansion as set forth in column 1 lines 65-68.

McMurray teaches the use of a diamond pattern which inherently provides differential expansion as claimed.

Alferness teaches the use of a knit which inherently includes differential expansion properties.

Conclusion


Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel G. Gilbert whose telephone number is 571-272-4725. The examiner can normally be reached on Monday-Friday 6:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenberg can be reached on 571-272-4726. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Samuel G. Gilbert
Primary Examiner
Art Unit 3736

sgg